

Remarks

In the March 14 Action, the Examiner refused to consider a previously submitted IDS.

The Examiner also denied a claim of priority on grounds that it was untimely.

Claims 1-28 were rejected under 35 U.S.C. § 112, second paragraph for allegedly being indefinite.

Claim 30 was rejected under § 112, first paragraph for allegedly lacking sufficient support.

Claims 1-7, 11, 15, 16, 18-24, 29 and 31 were rejected under 35 U.S.C. § 102(e) as anticipated by, or in the alternative, under § 103(a) as obvious over U.S. Patent 5,919,862 to Rajagopalan.

Claims 1-7, 11, 14-24 and 31 were rejected under § 102(b) or § 103(a) over JP 10305116.

Claims 1-7, 11, 14-24 and 31 were rejected under § 102(b) or § 103(a) over JP 62022841.

Claims 1-11 and 14-31 were rejected under § 102(b) or § 103(a) over WO 98/40127 to Rajagopalan.

Claims 8-10 and 25-28 were rejected under § 103(a) based upon the '862 patent to Rajagopalan, or the JP '116 document, or the JP '841 document, or WO '127 to Rajagopalan, in view of U.S. Patent 5,368,304 to Sullivan.

Claims 1-11 and 14-31 were rejected under § 102(e) or § 103(a) based upon U.S. Patent 6,384,140 to Melanson.

Claim 17 was rejected under 35 U.S.C. § 101 for double patenting based upon claim 1 of the '140 patent.

For the reasons set forth below, it is respectfully urged that claims 1-11 and 14-31 are in condition for allowance.

A. The Previously Filed IDS and Art Cited Therein Must Be Entered and Considered

In the March 14 Office Action, the Examiner refused to consider a previously submitted IDS. Specifically, the Examiner stated:

The IDS of 7/30/02 did not include copies of the references.

The Examiner, in the March 14 Action, included copies of the previously submitted 1449 form in which the art cited by Applicants was crossed out by the Examiner. It is unclear why the Examiner refuses to consider the cited art.

On March 19, 2003, Applicants forwarded a copy of the Supplemental Information Disclosure Statement filed on July 24, 2002, a copy of the PTO-1449 form and the two (2) references, as well as a copy of the returned postcard that was stamped by the U.S. Patent and Trademark Office on July 30, 2002 evidencing that the two (2) references were included in that initial filing.

A copy of the materials previously forwarded to the Examiner on March 19, 2003 is attached herewith as Exhibit A. Included herewith as part of that Exhibit are copies of the two (2) references.

Applicants respectfully submit that it is highly unfair and inequitable to penalize them by alleging that "[t]he IDS of 7/30/02 did not include copies of the references."

First, Applicants' files indicate that copies of the two (2) cited references were in fact submitted to the Office.

Second, the PTO acknowledged that it, in fact, received the "IDS, PTO-1449 and 2 Refs." mailed on July 24, 2002.

Applicants are puzzled why the Examiner refuses to consider the cited art. Even if that art was misplaced during transfer of the IDS and accompanying materials from the PTO mailroom to the actual application file, surely the Examiner could retrieve the documents on the PTO computer system.

Applicants submit that it would be a waste of the PTO's resources to petition this matter.

Again, Applicants request that the identified art be considered and made of record in the prosecution of this application. The two documents at issue were submitted to the Office on July 24, 2002; a second time on March 19, 2003; and now for a third time are also attached herewith in Exhibit A.

B. The Previously Submitted Priority Claim Should Be Entered

The Examiner refused to enter a previously submitted claim of priority for the following reasons:

The benefit claim filed on 12/20/02 was not entered because the required reference was not timely filed within the time period set forth in 37 CFR 1.78(a)(2) or (a)(5). If the application is an application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a nonprovisional application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the reference to the prior application must be made during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). If applicant desires priority under 35 U.S.C. 120 based upon a previously filed application, applicant must file a petition for an unintentionally delayed benefit claim under 37 CFR 1.78(a)(3) or (a)(6). The petition must be accompanied by: (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted); (2) a surcharge under 37 CFR 1.17(t); and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional. The petition should be directed to the Office of Petitions, Box DAC, Assistant Commissioner for Patents, Washington, DC 20231.

Pages 2-3 of the March 14, 2003 Action.

A petition to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of a prior-filed application has been submitted to the Office of Petitions concurrently with the filing of this Response. A copy of that Petition is enclosed with this Response as Exhibit B.

C. The Rejection of Claims 1-28 Based Upon § 112, Second Paragraph, Must Be Withdrawn

The Examiner rejected claims 1-28 (and apparently also claim 30) under § 112 arguing:

Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out

and distinctly claim the subject matter which applicant regards as the invention.

The isophtalic [sic, isophthalic] acid and terephthalic acids of claims 1 and 19 do not qualify as phthalic acid. "phthalic acid polyamide" must be construed as requiring units from phthalic acid. Any other interpretation would be repugnant to the ordinary meaning. Note that applicant (page 6 of spec.) clearly distinguishes between the three acid compounds.

Claim 30's "acrylate" is not understood. The specification does not add acrylate monomer to polyamide and ionomer.

Page 3 of the March 14 Action (bracketed text added)

Applicants acknowledge the Examiner's concern over the use of "phthalic acid." Many of the claims in the present application were previously amended to change a claim recitation from "isophthalic" to "phthalic." In addition, claim 31 is amended herein for consistency with the previous amendment. It is believed that the term "phthalic" encompasses all three isomers of that acid. Many artisans skilled in this field of art use the term "phthalic acid" to collectively refer to one or more of the particular isomers (See Exhibit C).

It is clear from the application as originally filed that Applicants' invention relates to the use of a polyamide that is reacted with one or more of any of the isomers, i.e. phthalic acid, isophthalic acid, and terephthalic acid. See page 7, lines 28-30 of the application.

Thus, the term "phthalic acid" as used in the present application refers to any of the isomers of phthalic acid.

If the Examiner still has concern or difficulty with the term "phthalic acid" and its use by Applicants to collectively refer to one or more of the three isomers, Applicants would welcome any suggestions by the Examiner as to more appropriate terminology.

Concerning claim 30, it is unclear why the Examiner considers the term "acrylate" in that claim to be limited to an acrylate monomer. There is no such limiting definition in the present application. Claim 30 broadly recites a mantle layer comprising polyphthalamide, an ionomer, and an acrylate. Claim 30 is not limited to an acrylate monomer. Extensive support for claim 30's recitation of an acrylate is found throughout the application such as at pages 7-11 and 24-27. It is well known that an "acrylate" refers to an ester of acrylic acid. "Acrylate" is often used as a synonym to refer to acrylic resins which, as the Examiner will

appreciate, are polymers or copolymers of acrylic acid, methacrylic acid, or acrylonitrile. See Exhibit D enclosed herewith.

For at least these reasons, the rejection under § 112, second paragraph, must be withdrawn.

D. The Rejection of Claim 30 Based Upon § 112, First Paragraph, Must Be Withdrawn

The Examiner asserted:

Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not support the inclusion of an acrylate (presumably monomeric) to blends of polyamide and ionomer.

Page 3 of the March 14 Action.

Upon closer review, it can be seen that the specification supports the inclusion of an acrylate with polyamide and ionomer. See page 9, lines 10-17; page 9, line 22 to page 11, line 1; page 24, line 27 to page 27, line 7. It is requested that this ground of rejection be withdrawn.

E. The Rejection of Claims 1-7, 11, 15, 16, 18-24, 29 and 31 Under § 102(e) or § 103(a) Based Upon U.S. Patent 5,919,862 to Rajagopalan Must Be Withdrawn

The Examiner rejected these claims contending that:

Claims 1-7, 11, 15, 16, 18-24, 29 and 31 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Rajagopalan '862 patent.

Rajagopalan suggests two or three piece golf balls. At least one of the layers is a sulfonated or phosphonated ionomer optionally blended with a polyamide (col. 29, lines 51-53). The polyamide can be based on isophthalic acid (col. 30, line 55) or terephthalic acid (col. 30 line 52).

Page 4 of the March 14 Action.

In response to Applicants' previous explanation concerning whether the '862 patent to Rajagopalan was prior art, the Examiner argued:

Applicant's arguments filed 12/20/02 have been fully

considered but they are not persuasive.

Applicant argues the instant application is now a CIP of the Melanson patent and therefore Rajagopalan '862, J '116 and Rajagopalan WO 98/40127 do not qualify as prior art.

Firstly, the priority claim was untimely. Secondly, even if the claim was timely, these references have effective date in 1998. Serial number 8-763070 does not support the aromatic polyamides now claimed. Therefore, applicant cannot have an effective date earlier than 3/10/00.

Pages 5-6 of the March 14 Action.

Applicants maintain their position that the cited art, including the '862 patent to Rajagopalan, are not prior art to the present application. However, to further prosecution of the application, Applicants request that this ground of rejection be withdrawn because the '862 patent also fails to anticipate or render obvious any of the claims at issue.

As the Examiner is well aware, anticipation requires that "every element of the claimed invention must be literally present, arranged as in the claim." *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 3 USPQ2d 1766 (Fed. Cir. 1987), *cert. denied*, 484 US 1007 (1988). "Anticipation under 35 U.S.C. § 102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention." *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 57 USPQ2d 1057 (Fed. Cir. 2000).

Independent claims 1, 18, 29 and 31 have each been amended to specifically recite that the respective cover layer or mantle consists essentially of a particular phthalic acid polyamide and an ionomer (or in the case of claim 18, an olefin/alkyl(meth)acrylate/carboxylic acid terpolymer).

The '862 patent discloses particular sulfonated or phosphonated ionomers that are employed in combination with a co-component polymer. The co-component polymer may be an ionomer or a non-ionomer polymer. If a non-ionomer polymer is utilized, that polymer may be polyamide. And, as pointed out by the Examiner, that polyamide may be a reaction product of a diamine with isophthalic acid or terephthalic acid. This is disclosed in columns 29 to 31 of the '862 patent.

However, the '862 patent fails to disclose a cover or mantle layer consisting essentially of a phthalic acid polyamide and an ionomer. Instead, the

'862 patent discloses a very specific class of sulfonated or phosphonated ionomers that may be used in conjunction with a polyamide or, a polyamide that is the reaction product of a diamine with isophthalic acid.

The ionomers claimed in the pending claims do not include the specific classes of sulfonated and phosphonated ionomers disclosed in the '862 patent. The present application does not include any mention of those classes of compounds. The term "ionomer" as used in the present application does not include the particular sulfonated or phosphonated compounds that are the subject of the '862 patent. Moreover, the '862 patent expressly distinguishes its sulfonated and phosphonated ionomers from the more general ionomers known in the art. See the background of the invention section of the '862 patent.

Furthermore, the amendments to the independent claims specifically exclude the sulfonated and phosphonated ionomers disclosed in the '862 patent. The terminology "consisting essentially of" excludes ingredients that materially affect the basic and novel characteristics of the claimed composition. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984).

According to the '862 patent, the use of sulfonated or phosphonated ionomers as opposed to general ionomers provides numerous advantages to the resulting cover or mantle, and so, necessarily affects the basic characteristics of the cover or mantle composition. See the background of the invention section of the '862 patent.

Therefore, none of claims 1, 18, 29, and 31 is anticipated by the '862 patent. These claims have all been amended to exclude ingredients that materially affect the basic characteristics of the cover or mantle, i.e. ingredients such as sulfonated or phosphonated ionomeric components. Since none of those claims is anticipated, then none of the claims dependent therefrom is anticipated, i.e. claims 6-7, 11, 15, 16, 19-24, and 31.

Before turning to the rejection under § 103 presented by the Examiner, it is instructive to first note several requirements for obviousness rejections. "Care must be taken to avoid hindsight reconstruction by using 'the patent in suit as a guide through the maze of prior art references, combining the

right references in the right way so as to achieve the result of the claims in suit'." *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 5 USPQ2d 1788 (Fed. Cir. 1988). "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps." *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). "Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references." *Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000). "A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered." *Bausch & Lomb, Inc. V. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). "There is no suggestion to combine...if a reference teaches away from its combination with another source." *Tec Air, Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999).

Concerning the Examiner's alternate obviousness rejection, that rejection fails since the '862 patent fails to teach the use of a golf ball cover or mantle that consists essentially of a phthalic acid polyamide and an ionomer. Instead, the '862 patent is directed to formulations of sulfonated or phosphonated ionomers that are combined with a co-component polymer. If one followed the teachings of the '862 patent, as the Examiner does in making the present rejection, one would be instructed to prepare a formulation based upon a sulfonated or phosphonated ionomer rather than an ionomer that did not contain such a group and which is described and claimed in the present application. Thus, the '862 patent does not teach the subject matter of the claims at issue. In fact, the '862 patent teaches away from the pending claims since it describes the advantages of using its sulfonated or phosphonated ionomers over more general non-sulfonated or non-phosphonated ionomers.

For at least these reasons, claims 1-7, 11, 15, 16, 18-24, 29, and 31 are patentable over the cited art, and the rejection under review must be withdrawn.

F. The Rejection of Claims 1-7, 11, 14-24 and 31 Under § 102(b) or § 103(a) Based Upon JP 10305116 Must Be Withdrawn

The Examiner rejected these claims by asserting:

Claims 1-7, 11, 14-24 and 31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the J 10305116 patent.

The reference blends ionomer and polyetheramide for use as golf ball covers. The polyetheramide also contains aromatic ester groups (see formula 1).

Presumably the same interactions between the ionomer and polyamide will be present in the reference as is for applicant (page 8, lines 5-17).

Page 4 of the March 14 Action.

Concerning Applicants' previous explanation as to why JP '116 was not prior art, the Examiner asserted:

Applicant's arguments filed 12/20/02 have been fully considered but they are not persuasive.

Applicant argues the instant application is now a CIP of the Melanson patent and therefore Rajagopalan '862, J '116 and Rajagopalan WO 98/40127 do not qualify as prior art.

Firstly, the priority claim was untimely. Secondly, even if the claim was timely, these references have effective date in 1998. Serial number 8-763070 does not support the aromatic polyamides now claimed. Therefore, applicant cannot have an effective date earlier than 3/10/00.

Pages 5-6 of the March 14 Action.

Again, as previously noted, Applicants maintain their position that the JP '116 document is not prior art to the present application. However, notwithstanding that matter, the Examiner's rejection based upon § 102 or § 103 must be withdrawn.

Upon closer review, it will be seen that the JP '116 document fails to disclose the subject matter of independent claims 1, 18, and 31. The JP '116 document entirely fails to disclose a golf ball cover composition consisting essentially of an ionomer and a phthalic acid polyamide formed from reacting at least one of phthalic acid and isophthalic acid, as recited in claim 1. Similarly, the JP '116 document entirely fails to disclose the subject matter of claim 18, i.e. a cover layer consisting essentially of a phthalic acid polyamide and an olefin/alkyl(meth)acrylate/carboxylic acid terpolymer. And, the JP '116 document

fails to disclose a method of making a golf ball involving a step of forming a cover layer from a composition consisting essentially of an isophthalic acid polyamide and an ionomeric component and wherein the amount of the isophthalic acid polyamide is at least 10% by weight as called for in claim 31.

Since none of claims 1, 18, and 31 is anticipated by the JP '116 document, then neither are any of the claims that depend from those independent claims, i.e. claims 2-7, 11, 14-17, and 19-24.

Concerning the Examiner's obviousness rejection based upon the JP '116 document, that rejection also fails. The JP '116 document entirely fails to teach the subject matter recited in the claims at issue. If one followed the limited description provided by the JP '116 document, one would be motivated to provide a golf ball having a cover containing a blend of ionomer and an aromatic polyamide rubber. The claims at issue all recite specific combinations containing a phthalic acid polyamide or, for independent claim 18, such a polyamide in combination with an olefin/alkyl(meth)acrylate/carboxylic terpolymer. Simply put, the JP '116 document fails to provide the requisite teaching necessary to properly support a rejection under § 103.

For at least these reasons, all of claims 1-7, 11, 14-24, and 31 are patentable over the JP '116 document and so, this ground of rejection must be withdrawn.

G. The Rejection of Claims 1-7, 11, 14-24 and 31 Under § 102(b) or § 103(a) Based Upon JP 62022841 Must Be Withdrawn

The Examiner rejected these claims on grounds that:

Claims 1-7, 11, 14-24 and 31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the J62022841 patent.

The reference produces golf ball covers of ionomer and an polyester amide from terephthalic acid (see registry No. 110485-64-8).

Page 4 of the March 14 Action.

In response to Applicants' previous explanation as to the JP '841 document, the Examiner alleged:

Applicant argues J '841 does not contain a phthalic acid

polyamidine.

This is not convincing. Registry number 110485-64-8 is derived from components including a diamine and 1,4benzenedicarboxylic acid (this is terephthalic acid). A diamine will react with a diacid to form a polyamide.

Page 6 of the March 14 Action.

Independent claims 1, 18, and 31 have been amended to specifically recite that the claimed golf ball has a cover consisting essentially of (i) a particular phthalic acid polyamide and (ii) an ionomer (claims 1 and 31) or, (i) a phthalic acid polyamide, and (ii) an olefin/alkyl(meth)acrylate/carboxylic acid terpolymer (claim 18).

The JP '841 document discloses a golf ball cover comprising (1) an ionomer, (2) amines containing primary or secondary amino groups, and (3) a "polymer from polyamides, polyamide oligomers, poly(alkylene terephthalate), and monovalent metal salts of ethylene-unsaturated carboxylic acid copolymers." The JP '841 document continues and notes formation of a cover as follows.

Thus, ethylene-methacrylic acid (94.5:5.5 mol) copolymer ionomer (60% ionized with Zn) 85, 1,3-bisaminomethylcyclohexane 5, and a caprolactam oligomer (no. av. polymn. degree 18, the end carboxyl blocked with n-hexylamine) 10 parts were blended in an extruder at 220.degree. and residence time .apprx.3 min. The blend showed melt flow rate 2.1 dg/min, flexural stiffness 500 MPa, tensile impact strength 305 (flow direction) and 250 (transverse) KJ/m², and impact resilience 67% vs. 0.7 dg/min, 280 MPa, 305 and 450 KJ/m², and 57%, resp., for the ionomer alone.

JP '841 Abstract (translated).

First, the JP '841 document fails to disclose or teach the specific subject matter of claims 1, 18, and 31. Moreover, claims 1, 18, and 31 have been amended to now specifically recite that the cover formulation excludes other agents that would affect the basic and material qualities of the formulation. The JP '841 document discloses and teaches the use of a variety of other agents in the golf ball covers.

Claim 31 is further distinguishable since it calls for a method of making a golf ball involving, in part, a step of forming a cover layer comprising at least 10% of isophthalic acid polyamide and an ionomeric component. The 'JP '841 document entirely fails to disclose or teach this particular step.

Additionally, the independent claims all recite that the particular phthalic acid polyamide that is used is formed from either, or both, phthalic acid (i.e. referring to the particular isomer) or isophthalic acid. The JP '841 document does not disclose this aspect. It only discloses the use of terephthalic acid.

The JP '841 document also fails to teach the particular aspects recited in the claims at issue and so, the obviousness rejection is misplaced and also must be withdrawn. For at least these reasons, the anticipation rejection must be withdrawn. The JP '841 document only teaches the use of terephthalic acid. That notation does not teach the use of the isomers phthalic acid or isophthalic acid in forming a particular polyamide that is combined with certain ionomers in accordance with the present invention.

Since independent claims 1, 18, and 31 are patentable over the JP '841 document, so, too, are the claims dependent therefrom.

For at least these reasons, claims 1-7, 11, 14-24, and 31 are patentable over the limited disclosure of the JP '841 document.

H. The Rejection of Claims 1-11 and 14-31 Under § 102(b) or § 103(a) Based Upon WO 98/40127 to Rajagopalan Must Be Withdrawn

The Examiner asserted that:

Claims 1-11 and 14-31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Rajagopalan WO 98/40127 patent.

Rajagopalan claims golf ball covers of 10-80% ionomer and 90-20% polyamide (claim 1). The polyamide can include units from terephthalic acid (page 15 line 4). The COR is high (Table II). Some of the ionomers used by Rajagopalan (i.e. surlyn (9320,9020,8320) are known to be terpolymer ionomers which are based on ethylene/acrylate/acid terpolymers (see applicant's Table 6). These ionomers have ester groups.

Pages 4-5 of the March 14 Action.

In response to Applicants' previous explanation as to why WO '127 is not prior art, the Examiner asserted:

Applicant's arguments filed 12/20/02 have been fully considered but they are not persuasive.

Applicant argues the instant application is now a CIP of the Melanson patent and therefore Rajagopalan '862, J '116 and Rajagopalan WO 98/40127 do not qualify as prior art.

Firstly, the priority claim was untimely. Secondly, even if the claim was timely, these references have effective date in

1998. Serial number 8-763070 does not support the aromatic polyamides now claimed. Therefore, applicant cannot have an effective date earlier than 3/10/00.

Pages 5-6 of the March 14 Action.

Again, Applicants maintain their position that the WO '127 document is not prior art to the present application. However, regardless of that matter, the WO '127 document entirely fails to support a rejection based upon alleged anticipation or obviousness.

Independent claims 1, 18, 29, and 31 recite a specific combination consisting essentially of a certain phthalic acid polyamide and an ionomer. These claims all recite that the particular phthalic acid polyamide that is used is formed from either, or both, phthalic acid (i.e. the particular isomer) or isophthalic acid. The WO '127 document does not disclose this aspect. It only discloses the use of terephthalic acid.

Since the WO '127 document does not anticipate any of the independent claims, then neither does that document anticipate any of the dependent claims at issue.

The WO '127 document also fails to teach the particular aspects recited in the claims at issue. As the Examiner correctly points out, the WO '127 document teaches the use of a polyamide based upon terephthalic acid. That mere mention, however, does not teach the use of the isomers phthalic acid or isophthalic acid in forming a polyamide that is combined with certain ionomers in accordance with the present invention.

For at least these reasons, all claims are patentable over the limited disclosure of the WO '127 patent.

I. The Rejection of Claims 8-10 and 25-28 Under § 103(a) Based Upon the '862 Patent to Rajagopalan, JP '116, JP '841, or WO '127 to Rajagopalan in View of U.S. Patent 5,368,304 to Sullivan Must Be Withdrawn

The Examiner rejected claims 8-10 and 25-28 by contending;

Claims 8-10 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Rajagopalan '862 patent or J 10305116 or J 62022841 or Rajagopalan WO 98/40127 in view of Sullivan '304.

The primary references may not report compression or COR values for their balls. However, these values are conventional as shown by Sullivan's table (col. 23). It would have been obvious to ensure the balls of primary references have compression and COR values within normal parameters.

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The '304 patent to Sullivan fails to remedy the previously noted deficiencies of the '862 patent to Rajagopalan, the JP '116 document, the JP '841 document, and the WO '127 document.

Further, the Examiner did not provide any showing of a teaching or motivation to combine the '304 patent with any of the other documents.

Upon closer review, it is evident that if one followed the teachings of the '304 patent, as one must pursuant to the Examiner's reliance on that patent, then one would be motivated to provide a dramatically different golf ball as compared to the golf balls recited in the pending claims. The '304 patent specifically instructs that the cover composition is formed from one or more ionomer resins. There is no mention of using a polyamide and entirely no mention of utilizing a particular type of polyamide formed from phthalic acid or isophthalic acid.

In addition, the '304 patent teaches a single cover layer ball. There is no suggestion in the art, nor provided by the Examiner, as to why, or how, selective passages of the '304 patent may be combined with other selected teachings from the multitude of other references relied upon by the Examiner.

For at least these reasons, each of claims 8-10 and 25-28 are patentable over the collection of art cited by the Examiner.

J. The Rejection of Claims 1-11 and 14-31 Under § 102(e) or § 103(a) Based Upon U.S. Patent 6,384,140 to Melanson Must Be Withdrawn

The Examiner rejected these claims as follows:

Claims 1-11 and 14-31 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Melanson '140 patent.
The reference clearly meets the claims.

Page 5 of the March 14 Action.

In response to Applicant's previous explanation as to why the '140 patent to Melanson is not prior art, the Examiner contended:

Melason '140 is also prior art because the inventive entity is different than the instant application. Only the "commonly owned" statement will remove Melanson '140 as prior art.

Page 6 of the March 14 Action.

The present application is a continuation-in-part (CIP) of the '140 patent to Melanson. As previously explained, a Petition is being filed concurrently herewith to formally make that priority claim of record in this application.

Moreover, pursuant to 35 U.S.C. § 103(c), the '140 patent to Melanson shall not preclude patentability of the pending claims because the subject matter of the '140 patent (and the '140 patent itself) and the presently claimed invention were, at the time the invention was made, owned by the same party or subject to an obligation of assignment to the same party.

For at least these reasons, the rejection of claims 1-11 and 14-31 must be withdrawn.

K. The Rejection of Claim 17 Under § 101 for Double Patenting Must Be Withdrawn

The Examiner rejected claim 17 on grounds that:

Claim 17 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6384140. This is a double patenting rejection.

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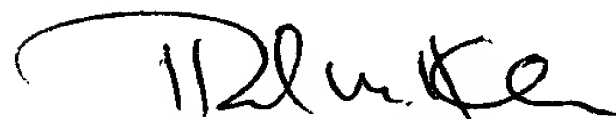
In view of the amendments to claim 1, namely the incorporation of the language "consisting essentially of," this ground of rejection is moot.

L. Conclusion

In view of the foregoing, claims 1-11 and 14-31 are patentable over the cited art and in condition for allowance.

Respectfully submitted,

FAY, SHARPE, FAGAN,
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A handwritten signature in dark ink, appearing to read "R. Klein", is written over a horizontal line.

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